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**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/319,828

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GUENTER

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GUENTER-1 (P)

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1077 NORTHERN BOULEVARD
ROSLYN NY 11576-1696

IM62/0922

EXAMINER

AHMED, S

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

09/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/319,828

Applicant(s)
Walther

Examiner
Sheeba Ahmed

Group Art Unit
1773



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a plastic layer having release properties “wherein *the materials*” that produce the release properties are incorporated in the plastic layer and “*can be extruded with it*”. There is no antecedent basis for “the materials” in claim 1 and it is unclear what is meant by “can be extruded”. Are the plastic layer and “the materials” extruded together or not?

Claim 2 recites that “*the basic polymer* is provided with “*modified properties*”. There is no antecedent basis for “the basic polymer” in claims 1 or 2 and it is unclear what is meant by “modified properties”. No definition of “modified properties” has been provided in the Specification or the claims.

Claim 3 recites that “*the release additive*” is “*based on* silicone compounds”. There is no antecedent basis for “the release additive” in claims 1 or 3 and it is unclear what is meant by “based on”. No definition of “based on” has been provided in the Specification or the claims.

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Claim 4 recites that the release additives are “*substances similar to polyolefins*”. It is unclear what is meant by “substances similar to polyolefins”. For purposes of examination, the Examiner has interpreted the above ambiguous phrase to indicate that the release additives are in fact polyolefins. Clarification is required.

Claim 5 recites that “*the release additives* are incorporated into *the plastic* during polymerization”. There is no antecedent basis for “the release additive” or “the plastic” in claims 1 or 5.

Claim 6 recites that “*the release additives* are embedded *firmly* in *the plastic matrix*”. There is no antecedent basis for “the release additive” or “the plastic matrix” in claims 1 or 6. Furthermore, the term “firmly” is a relative term which renders the claim indefinite since it is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 7 recites that the release additives are “fillers that are, *for example, structured as inorganic compounds*”. The phrase “for example” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, it is unclear what is meant by “structured as inorganic compounds”. For purposes of examination, the Examiner has interpreted the above ambiguous phrase to indicate that the release additives are inorganic fillers. Clarification is required.

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Claims 8-10 recite that "*the layer*" is manufactured from a master batch, by a coextrusion process or extruded together with a substrate layer, respectively. There is no antecedent basis for "the layer" in any of the above mentioned claims.

Claims 11 and 12 recite that "*the layer* is extruded onto a substrate web, *for example*, a web of paper" or "*the layer* is located on either one or both sides of a substrate layer". There is no antecedent basis for "the layer" in any of the above mentioned claims and the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 13 recites that "*the thickness*" of "*the layer*" is in "*the 5 mm range*" and claim 14 recites that the plastic layer and/or "*the substrate film*" is embossed. There is no antecedent basis for "the thickness", "the layer", "the 5 mm range" or "the substrate film" in any of the above mentioned claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 6, 8, 9, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger et al. (US 3,726,710).

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Berger et al. disclose a curable release composition used as a release layer (*equivalent to the plastic layer of the claimed invention*) and a paper substrate (*equivalent to the substrate web of the claimed invention*) coated with the silicon release composition (Column 1, lines 7-11). The silicone release composition comprises a mixture of an organopolysiloxane starting material (*wherein one component is equivalent to the basic polymer and the other is equivalent to the silicone compound of the claimed invention*)(Column 3, lines 42-48). The determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the plastic layer) is the same despite the process limitations of incorporation during polymerization or by a coextrusion process. All limitations of the claimed invention are disclosed in the above reference.

3. Claims 1, 2, 4-9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman et al. (EP 0622411A2).

Friedman et al. disclose polypropylene (*equivalent to the basic polymer of the claimed invention*) and polymethylpentene (*equivalent to the polyolefin compound of the claimed invention*) blends and their use as release sheets (*equivalent to the plastic layer of the claimed invention*) (Page 1). The release properties of the release sheet can be further adjusted by

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employing one or more inorganic fillers (*equivalent to the inorganic fillers of the claimed invention*) (Page 3). The blend can be used to form article or sheets for embossing or can be extruded to produce of release liners and release films (Page 4). The determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the plastic layer) is the same despite the process limitations of incorporation during polymerization or by a coextrusion process. All limitations of the claimed invention are disclosed in the above reference.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-3, 5, 6, 8-10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Higgins (US 5,932,352).

Higgins discloses a release film comprising a polymeric film substrate (*equivalent to the substrate of the claimed invention*) and a release layer (*equivalent to the plastic layer of the*

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claimed invention) formed from a silicone resin (*equivalent to the silicone compound of the claimed invention*) and a polymer (*equivalent to the basic polymer of the claimed invention*)(Column 1, lines 57-61). The silicone resin may be a polysiloxane (Column 4, lines 35-37). The release film may vary in thickness depending on the application (Column 8, lines 43-48). The determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the plastic layer) is the same despite the process limitations of incorporation during polymerization or by a coextrusion process. All limitations of the claimed invention are disclosed in the above reference.

5. Claims 1, 2, 4-6, 8-10, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Adamko et al. (US 5,948,517).

Adamko et al. discloses release films (*equivalent to the plastic layer of the claimed invention*) made of thermoplastic materials such as a blend of two or more LLDPE's (*wherein one component is equivalent to the basic polymer and the other is equivalent to the polyolefin material of the claimed invention*) that may be applied to a polymeric adhesive surface (*equivalent to the substrate of the claimed invention*) wherein the adhesive surface may be textured (*thus meeting the limitation that the substrate may be embossed*) (Column 3, lines

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15-18 and Column 4, lines 60-64). The film may be cast or extruded and preferably has a thickness of 0.01 to 0.5 mm (Column 5, lines 45-48). All limitations of the claimed invention are disclosed in the above reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (US 3,726,710).

Berger et al., as discussed above, disclose the claimed invention but do not specifically state that the plastic layer has a thickness of 5mm. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to have determined the optimum thickness of the plastic layer through routine experimentation in the absence of a showing of criticality in the claimed size.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al. (EP 0622411A2).

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Friedman et al., as discussed above, disclose the claimed invention but do not specifically state that the plastic layer has a thickness of 5mm. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to have determined the optimum thickness of the plastic layer through routine experimentation in the absence of a showing of criticality in the claimed size.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Higgins (US 5,932,352).

Higgins, as discussed above, disclose the claimed invention but do not specifically state that the plastic layer has a thickness of 5mm. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to have determined the optimum thickness of the plastic layer through routine experimentation in the absence of a showing of criticality in the claimed size.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamko et al. (US 5,948,517).

Adamko et al., as discussed above, disclose the claimed invention but do not specifically state that the plastic layer has a thickness of 5mm. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to have determined the optimum

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thickness of the plastic layer through routine experimentation in the absence of a showing of criticality in the claimed size.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.



Sheeba Ahmed
September 20, 2000



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700